

REMARKS

The Final Office Action mailed June 23, 2008, the Advisory Action mailed August 28, 2008, and the Notice of Non-Compliant Amendment mailed January 6, 2009 have all been received and reviewed. AMENDMENT B filed August 12, 2008 was not entered by the Examiner, per the Advisory Action. AMENDMENT C has been deemed non-compliant and also denied entry. Therefore, as of the May 8, 2008 AMENDMENT A, Claims 1-4, 6-13, 15-25 and 27-31 were pending and presently stand rejected.

The Examiner has indicated that the amendments introduced in AMENDMENT B will require additional search and consideration. Applicant filed a Request for Continued Examination (RCE) with fee in AMENDMENT C. The further amendments introduced in AMENDMENT C have also been denied entry. To obtain entry of the original amendments with arguments introduced in AMENDMENT B and the subsequent amendments and arguments in AMENDMENT C, Applicant submits this AMENDMENT D.

Applicant has amended Claims 1, 4, 11-13, 17-18, 25 and 29 herein. Applicant has added two new Claims 32-33. As of this AMENDMENT D, Claims 1-4, 6-13, 15-25 and 27-33 are believed to be in condition for allowance and Applicant respectfully requests reconsideration of the application as amended herein.

Claim Objections

The Examiner has objected to Claim 4 because of improper dependency. Applicant has amended Claim 4 to depend from Claim 3. The Examiner has further objected to Applicant's use of trademark symbols in Claims 11-12.

Applicant has studied the current list of Microsoft Corporation trademarks, both registered and common law, as suggested by the Examiner. The list of Microsoft® trademarks, both registered and common law, appears to suggest that Microsoft® considers the individual terms "Windows", "Word" and "Project" to be neither registered (®) nor considered common law trademarks (™). However, Microsoft Corporation holds two active trademark registrations for the mark "Microsoft Windows", see, Registration Nos. 1,959,130 and 2,285,870. Additionally, Microsoft Corporation holds

at least one active registration for the mark "Microsoft", see Registration No. 2,285,870. Similarly, Microsoft Corporation holds a trademark registration for "Excel", see Registration No. 2,942,050. In view of these registrations, Applicant asserts that "MICROSOFT®", "MICROSOFT WINDOWS®" and "EXCEL®" are registered trademarks of Microsoft Corporation.

In view of this analysis and suggested practice in M.P.E.P § 608.01(v), Applicant has amended Claims 11 and 12 to capitalize and append the ® symbol to known trademarks of Microsoft Corporation.

Similarly, with regard to Applicant's use of the term POST-IT® note, Applicant has amended Claims 1, 17, 18, 25 and 29 to use the generic descriptive term "adhesive-backed paper note" in place of "POST-IT® note", in order to avoid any trademark misuse.

35 U.S.C. § 103(a) Obviousness Rejections

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, reaffirmed the objective analysis for determining obviousness under 35 U.S.C. § 103: "[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved." 127 S.Ct. 1727, 1729-30, (U.S. 2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)).

M.P.E.P. 706.02(j) sets forth the contents of a Section 103(a) rejection:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clap*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in view of U.S. Patent No. 5,682,695 to Hoffman in further view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al.

The Examiner has rejected Claims 1-4, 6-12 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes in view of Hoffman in further view of Riley et al.

The Examiner asserts that Spain discloses “generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and a duplicate computer readable symbology of the note information”, citing to Spain, FIG. 1A, Office Action, page 3, ¶ 10. Applicant concedes that Spain teaches serial numbers or delivery instructions printed in text on labels with duplicate computer readable information in barcodes on the labels of Spain. However, Applicant seeks clarification on the Examiner’s assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of the printed barcode labels in a meeting environment, as disclosed by Rhodes in the system disclosed by Spain, for the motivation of providing an additional use of barcoded labels.” Office Action p. 4, ¶ 13.

Applicant can find no such motivation in the Spain reference. On the contrary, Applicant asserts that the intended application of Spain teaches away from “moving” and “organizing” of an adhesive-backed paper note because such a note is configured to be removable and moved, whereas the product labels taught by Spain are configured to be permanently attached to the goods on which they are attached. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1984); M.P.E.P. § 2141.02, VI. Furthermore, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Post-It note labels would be unsuitable for the application of the base reference, Spain, because they could easily fall off during shipping and stocking, because the “sticky notes” are intended to be removable.

Applicant asserts that the Spain labels were never intended to be used in the context of “generating and organizing information in a meeting”. The information

printed on Spain labels is static and preselected based on the goods, barcode standards and the languages chosen. Whereas the information gathered and organized during a meeting in the context of the present invention is dynamic and based entirely on the information generated during the meeting.

Finally, there is neither disclosure nor suggestion that the labels generated in Spain are printed on Post-It® note media, moved to and organized in a selected repository, scanned and then placed into a selected computer software application as in the present invention.

Based on Applicant's understanding of the cited portions of Rhodes, it appears that the Rhodes barcodes are used to index portions of information that a user would like to integrate into the user's notes. The Rhodes barcodes do not appear to be a "duplicate computer readable symbology of the note information" as recited in Claim 1. Rather, the Rhodes "barcode may also be used to represent the indexing information. The barcode may be placed next to the static visual representation corresponding to the barcode." ¶ [0116]. Applicant notes that even if Rhodes teaches the use of barcodes in the context of a meeting, that use is simply as a means of indexing information presented to the user for selected insertion into the user's own notes. Rhodes does not teach barcodes that are "a duplicate computer readable symbology of the note information" or "printing the notes on an adhesive-backed paper note" as recited in amended Claim 1.

Applicant can find no suggestion or motivation in Rhodes to incorporate the printed barcode labels disclosed in Spain in the system of Rhodes. The problem solved by Rhodes is integrating multimedia presentation information into a set of user notes. Rhodes does not disclose the generation of notes with user information in text and a duplicate of the text in a barcode. Rather, Rhodes allows a user to take notes by hand and then augment those notes with multimedia at selected points within the user's notes. The barcodes disclosed in Rhodes are not duplicative of "discrete portions of information" content of the present invention. Rather, the barcodes in Rhodes are merely used as an index to the multimedia content that is selectively inserted into the user's notes. Furthermore, Rhodes does not appear to disclose or suggest that user

generated content may be duplicated in a barcode, printed on Post-It® note media, moved to and organized in a selected repository, scanned and then placed into a selected computer software application as in the present invention.

The Examiner further asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have included organizing notes on a clipboard, as disclosed by Hoffman, in the system of Rhodes for the motivation of providing a means for presenting information in a meeting.” Office Action, p. 4, ¶ 15. Applicant acknowledges that use of walls, bulletin boards, or clip boards to manipulate adhesive-backed notes that are hand-written” or preprinted is well known in the prior art.

Applicant seeks clarification why the use of a clipboard as disclosed in Hoffman would be something that one of skill in the art would logically want to combine with the labels of Spain and the augmented note system of Rhodes. It would seem equally plausible that one of skill in the art would avoid the labels of Spain because they are not capable of being “removably affixed to provide an interactive function” Col. 1:6-13 as taught by Hoffman. The labels of Spain are configured to fixedly attach to their respective goods and are not removable.

The Hoffman reference is perhaps the closest to the actual intended application of the present invention. But, Hoffman merely provides a portable note organizer that is manual and not automated. Hoffman provides neither disclosure nor suggestion of using user generated and printable notes as recited in Claim 1. Applicant argues that Hoffman teaches away from printing adhesive-backed notes because a user can simply use one of the markers 20 provided in the Hoffman system to manually write a note.

The Examiner further asserts and Applicant acknowledges that printing and reading barcodes on a Post-It® note is known in the prior art, see Riley et al., ¶¶ [0009] and [0017]. The Examiner asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have included printed Post-It® notes, as disclosed by Riley, in the system of Hoffman for the motivation of providing information for display on the clipboard.” Office Action, p. 4, ¶ 17.

However, it is apparent that the barcode printed on Post-It® note according to

the teachings of Riley et al. is merely an identification code associated with a particular page of a website that upon reading, for example with a barcode reader, "will automatically activate the indicated website page." Riley et al., ¶¶ [0007] and [0015]. Thus, the Riley et al. barcode is not "a duplicate computer readable symbology of the note information" as recited in amended Claim 1.

Applicant seeks clarification why one of skill in the art would be motivated to use the printed barcodes of Riley et al. in the manual system of organizing and generating notes of Hoffman. As noted above, Hoffman's system is standalone and does not require any printer to generate notes. In fact, the stated purpose for the Hoffman invention is that "[i]t is desirable to provide a wall mountable or smaller, hand carried note organizer which is portable and fully integrated." Col. 1:54-56.

The Riley et al. reference discloses a solution to the problem of linking a multimedia message to a physical object. Though Riley et al. discloses printing barcodes on Post-It® note media, the barcode information is not duplicative of the message information. In fact, the barcode of Riley et al. is simply an identification link to a website. Applicant can find no motivation or suggestion in Riley et al. to use the printed barcodes on Post-It® note media for organizing meeting notes.

The Examiner asserts that "the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." Applicant respectfully argues that the only motivation for making the asserted combination of prior art references can be found in Applicant's disclosure and not in the prior art. Applicant respectfully argues that the Examiner is using impermissible hindsight. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006); M.P.E.P. § 2143.01, I.

The purpose of Applicant's invention is to be able to generate printed Post-It® notes for use in brain-storming sessions or other meetings where a group of people are generating ideas or planning tasks to accomplish a common goal. Applicant's notes are novel and nonobvious because of the duplicate information that is included on each note in the form of a barcode. The visually perceptible information (text) is readily

viewable by users of the inventive method. The duplicate computer readable symbology of the note information (barcode) allows the user to gather information from the notes in any order and pull that information into an application by scanning for further processing.

Claims 2-4, 6-12 depend from amended Claim 1, and thus are believed to be allowable for the same reasons. Claim 29 has been amended to include the same amendments introduced into Claim 1. For this reason, Claim 29 is believed to be allowable over Spain in view of Rhodes in view of Hoffman in further view of Riley et al. Claims 30-31 depend from amended Claim 29, and are thus believed to be allowable for the same reasons as amended Claim 1.

For all of these reasons, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 1-4, 6-12 and 29-31 based on Spain, Rhodes, Hoffman and Riley et al.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes

The Examiner has rejected Claims 13, 15-16 and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes. More specifically, the Examiner asserts that Spain discloses: "receiving discrete portions of information using the computer keyboard and formatting each of the discrete portions of information as an output, wherein each output includes a visually perceptible version of each discrete portion of the information and a duplicate computer readable symbology of each discrete portion of the information".

Applicant has amended Claim 13 to recite the limitation: "wherein the discrete portions of information include at least the following: a note category, a textual description, a user field, a duration, an owner identification, a dependency and a user-defined field." Support for this added limitation may be found in ¶ [0017] of the as-filed specification and original Claim 7. Neither Spain nor Rhodes discloses this added limitation. For this reason, amended Claim 13 is believed to be nonobvious over the asserted combination of Spain and Rhodes.

Claims 15-16 and 19-24 depend from amended Claim 13. Thus, Claims 15-16 and 19-24 are believed to be allowable over the asserted combination of Spain and Rhodes for at least the same reason as Claim 13. In view of this amendment and the arguments above, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 13, 15-16 and 19-24.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in further view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al.

Claims 17, 25 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spain, Rhodes and Riley et al.

Claim 17 depends from amended Claim 13. As noted above, Applicant asserts that Spain and Rhodes fail to disclose or suggest all of the limitations of amended Claim 13. Riley et al. also fails to disclose the added limitation in amended Claim 13. Therefore, Applicant asserts that Claim 17 is nonobvious over Spain, Rhodes and Riley et al. for at least the same reasons as amended Claim 13.

Applicant has amended Claim 25 to recite the following additional limitation: "wherein the information comprises at least the following: a note category, a textual description, a user field, a duration, an owner identification, a dependency and a user-defined field." Thus, Applicant asserts that amended Claim 25 is nonobvious over Spain, Rhodes and Riley et al. because none of these references discloses the added limitation in Claim 25. Claim 28 depends from amended Claim 25. Thus, Applicant asserts that Claim 28 is nonobvious over Spain, Rhodes and Riley et al. for at least the same reasons as amended Claim 25.

For these reasons, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 17, 25 and 28 over Spain in view of Rhodes and further in view of Riley et al.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al. in further view of U.S. Patent No. 5,682,695 to Hoffman

Claims 18 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes in view of Riley et al. and in further view of Hoffman.

Claim 18 depends from Claim 17, which depends in turn from Claim 16, which in turn depends from Claim 15, which in turn depends from Claim 13. Therefore, Claim 18 includes all of the limitations of Claims 13 and 15-17.

As noted above, neither Spain nor Rhodes nor Riley et al. "wherein the discrete portions of information include at least the following: a note category, a textual description, a user field, a duration, an owner identification, a dependency and a user-defined field" as recited in amended Claim 13. Hoffman does not appear to disclose this limitation either. Thus, Applicant asserts that Claim 18 is nonobvious over Spain, Rhodes, Riley et al. and Hoffman for at least the same reasons as amended Claim 13.

Similarly, Applicant has already argued the nonobviousness of amended Claim 25 from which Claim 27 depends. Hoffman does not appear to disclose "wherein the information comprises at least the following: a note category, a textual description, a user field, a duration, an owner identification, dependency and a user-defined field" as recited in amended Claim 25. Thus, Applicant asserts that Claim 27 is nonobvious over Spain, Rhodes, Riley et al. and Hoffman for at least the same reasons as amended Claim 25.

In view of the amendments and arguments above, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 18 and 27 over Spain in view of Rhodes in view of Riley et al. and in further view of Hoffman.

Claims 32-33

Claims 32-33 depend from original Claim 7 and merely claim specific embodiments of original Claim 7 which depends from Claim 1. In view of the dependency of Claims 32-33 on Claims 7 and 1, Applicant asserts the patentability for the same reasons as Claim 1.

CONCLUSION

Applicant seeks entry of this AMENDMENT D in view of the previously filed RCE and fee paid. Claims 1-4, 6-13, 15-25 and 27-33, are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

Respectfully Submitted,



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